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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,188	04/02/2004	Dustin W. Smith	42435-006	2159
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HUSCH & EPPENBERGER, LLC 190 CARONDELET PLAZA SUITE 600 ST. LOUIS, MO 63105-3441				
			EXAMINER KOEHLER, CHRISTOPHER M	
			ART UNIT 3726	PAPER NUMBER

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/817,188

Applicant(s)

SMITH ET AL.

Examiner

Christopher M. Koehler

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-14, 16, 17, 20-25 and 27 is/are rejected.
- 7) ☒ Claim(s) 6-8, 15, 18, 19, 26 and 28-40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/26/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because the same reference characters have been used to designate different features of both embodiments. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 300-392. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by

the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities:
4. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: reference numerals for figures 11-21, and reference of figure 20 for the bias springs (92 or 392) which are found in figure 21.
5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Appropriate correction is required

### ***Claim Objections***

6. Claim 1 is objected to because of the following informalities: In line 18 "stat" should be --slat--. Appropriate correction is required.
7. Claim 13 is objected to because of the following informalities: In line 1 "is" should be changed to --has--. Appropriate correction is required.

8. Claim 16 is objected to because of the following informalities: In line 13 "slot" should be changed to –slat–. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

9. Claims 2 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Both claims state that a block is placed on a position fixture or maintenance device at a first preconfigured location of the second driver and at at least one other preconfigured location of the second driver and that a block fixator fixes the blocks to the slat at said preconfigured locations of the second driver. It is unclear how this is performed because the use of the term "position fixture" in the specification refers to the second embodiment of the invention, figures 11-21, in which the block fixator is downstream of the block dispensing station. In this embodiment it would be impossible for the blocks to be fixed while the second driver is in this first preconfigured position. Claim 2 could read on the first embodiment of the invention, figures 1-10, because in this embodiment the block is fixed at the same location that it is dispensed and therefore in the first preconfigured location and a position fixture, i.e. the clamping means, is present at this location. It is therefore unclear to which embodiment of the invention the applicant is claiming rendering the claims indefinite for the purposes of examination.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States:

11. Claims 1-5, 9-17 and 20-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Vial (US Patent No. 3,968,560).

12. Regarding claim 1, Vial teaches a method of assembling pallets comprising, providing an automated pallet assembly apparatus (figure 1) having an assembly path, a slat dispensing station (58, figure 3), and a block dispensing station (16), the assembly path operatively connecting the slat dispensing station to the block dispensing station, providing a plurality of slats to the slat dispensing station of the assembly apparatus, each of the plurality of slats having a longitudinal length, a lateral width, and a transverse thickness, the longitudinal length of each of the plurality of slats defining first and second longitudinal ends of the respective slat, providing a plurality of blocks to the block dispensing station of the assembly apparatus, utilizing the assembly apparatus to automatically longitudinally move a first one of the plurality of slats (54) along the assembly path from the slat dispensing station toward the block dispensing station and to automatically stop the movement of the first slat at a first position along the assembly path (when the first block and first slat are biased together under the first nailer), the first position being such that the first longitudinal end of the first slat is positioned adjacent the block dispensing station along the

assembly path, automatically biasing a first block of the plurality of blocks into engagement with the first slat via the assembly apparatus, the engagement of the first block with the first slat occurring with the first slat stopped in the first position such that the first block engages the first slat adjacent the first longitudinal end of the first slat, and automatically fastening the first slat to the first block while the first slat and the first block are being biased into engagement with each other.

13. Regarding claim 2, Vial teaches a pallet assembly apparatus comprising: a slat dispenser (58) disposed to dispense individual slats (12) to a first individual slat driver (62), said first slat driver being operative to move said individual slats to an assembly station, a second slat driver (178), at least said second slat driver being selectively positionable, at least one block dispenser (116), said block dispenser being disposed to dispense a block to said assembly station, a position fixture disposed to operatively cooperate with said second slat driver and said at least one block dispenser to position the dispensed block abutting the individual slat when said second slat driver is in a first selected position, at least one other position fixture disposed to operatively cooperate with said second slat driver to position a second dispensed block abutting the individual slat when said second slat driver is in at least one other selected position, a block fixator (80) disposed to fix said first dispensed block to said slat when said second slat driver is in said first selected position and further disposed to attach said at least one other block to the individual slat when said second slat driver is in said at least one other position.

14. Regarding claim 3, Vial teaches that the block fixator (80) is at a separate work station from the block dispenser (116).

15. Regarding claim 4, Vial teaches that the block fixator is at an attachment station having a clamping device disposed to clamp each dispensed block against the slat (figures 7-12).

16. Regarding claim 5, Vial teaches a stringer ejector (238, figure 1A).

17. Regarding claim 9, Vial teaches that the first slat driver includes a chain (62 figure 1A).

18. Regarding claim 10, Vial teaches that the second slat driver includes a chain (178, figure 1A).

19. Regarding claim 11, Vial teaches that the first and second slat drivers both include chains and that the chains each turn in a gear set.

20. Regarding claim 12, Vial teaches that the first block dispenser is a piston (136, figure 9) having a tooth (116).

21. Regarding claim 13, Vial teaches that the second slat driver has a drive wheel operative to drive the chain drive.

22. Regarding claim 14, Vial teaches that the position fixtures (179, figure 9) are on a chain.

23. Regarding claim 16, Vial teaches a method of producing pallets comprising: driving an individual slat (12) to a first selected position, dispensing a first block (14) to abut the individual slat a preconfigured location on said individual slat when said individual slat is in said first selected position, maintaining the first block in said first preconfigured location relative to the



individual slat, driving said individual slat to a second selected position, dispensing a second block to abut the individual slat at a second preconfigured location when said individual slat is at said second selected position, maintaining the second block on the individual slat at said second preconfigured location, fixing the first block to the individual slat, and fixing the second block to the individual slat (figure 1A).

24. Regarding claim 17, Vial teaches that the fixing is by nailing.

25. Regarding claim 20, Vial teaches ejecting a finished pallet (238).

26. Regarding claim 21, Vial teaches that the driving step is executed by a drive chain (178) having position fixtures (179) attached thereto.

27. Regarding claim 22, Vial teaches that the driving step has two drivers (62 and 178) each with position fixtures (66 and 179).

28. Regarding claim 23, Vial teaches that the first and second drivers both include chains and that each chain is connected through a gear set.

29. Regarding claim 24, Vial teaches that the slats are dispensed from a magazine being adjustable to dispense different size slats (34).

30. Regarding claim 25, Vial teaches that a block magazine (16) disposed to feed said first block dispenser.

### ***Double Patenting***

31. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the

reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

32. Claims 1, 2, 13, 16 and 17 are rejected on the ground of nonstatutory double patenting over claims 1-11 of U. S. Patent No. 6,763,567 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

33. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

34. Regarding claim 1, for double patenting to exist as between rejected claim 1 and patent claim 1, it must be determined that the rejected claim is not patentably distinct from patent claim 1. In order to make this determination, it first must be determined whether there are any differences between the rejected claims and claim 1 and, if so, whether those differences render the claims patentably distinct. Rejected claim 1, recites word for word patent claim 1 in col. 9, lines 14-47. It is clear that all the elements of rejected claim 1 are to be found in patent claim 1. The difference between rejected claim 1 of the application and

claim 1 of the patent lies in the fact that the patent claim includes many more elements and is thus much more specific. Thus the invention of claim 1 of the patent is in effect a “species” of the “generic” invention of rejected claim 1. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since rejected claim 1 is anticipated by claim 1 of the patent, it is not patentably distinct from claim 1.

35. Regarding claim 2, patent claim 1 teaches an automated pallet assembly apparatus having a slat dispenser, a block dispenser, an assembly path connecting the slat and block dispensers, a first driver disposed to drive a first slat to a first preconfigured location and a block fixator disposed to fasten a dispensed block to a slat in a first preconfigured location and at least one other block to the slat at at least one other preconfigured location. Patent claim 6, dependent of claim 5 which is dependent of claim 4 which is ultimately dependent of claim 1 teaches multiple “position fixtures” which automatically bias the dispensed blocks into engagement with the guide surface of the assembly apparatus when the slat is stopped in the preconfigured locations. Patent claim 7, dependent of claim 4 which is ultimately dependent of claim 1 teaches that the steps of utilizing the assembly apparatus to automatically longitudinally move the first slat from the first position to a second position takes place with a separate driver than that which drives the slat to the first preconfigured location.

36. Regarding claim 13, patent claim 7 which is dependent of claim 4 which is ultimately dependent of claim 1 teaches that the second driver has at least two drive wheels.

37. Regarding claim 16, patent claim 1 teaches a method for producing individual stringers for block pallets comprising driving a slat to a first selected position, dispensing a block to abut the individual slat at a preconfigured location on the slat when the slat is in the first selected position, biasing the first block in the first preconfigured location, fixing the first block to the slat, driving the slat to a second selected position, dispensing a second block to abut the slat at a second preconfigured location when the slat is at the second selected position, biasing the second block on the slat at the second preconfigured location and fixing the second block to the slat.

38. Regarding claim 17, patent claim 10, dependent of claim 1 teaches that the fixing is by stapling.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

#### ***Allowable Subject Matter***

39. Claims 6-8, 15, 18, 19 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

40. Claims 27-40 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

41. The following is a statement of reasons for the indication of allowable subject matter:

42. Regarding claims 6-8, 18, 19, 26 and 27, the prior art fails to teach a second block driver in combination with the limitations of the claims.

43. Regarding claim 15, the prior art fails to teach biasing springs for biasing the block into the position fixture in combination with the limitations of the claims.

### ***Conclusion***

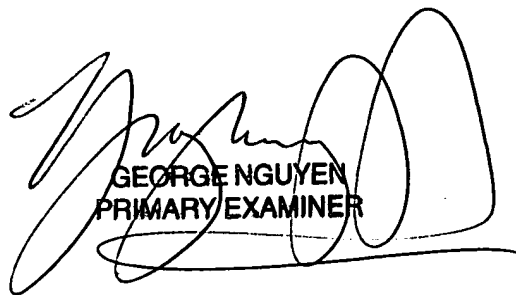
44. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Koehler whose telephone number is (571) 272-3560. The examiner can normally be reached on Mon.-Fri. 7:30A-4:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Nguyen can be reached on (571) 272-4491. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CMK

A stylized, handwritten signature in black ink, featuring large, sweeping loops and a horizontal line at the bottom. The signature is positioned over the printed name and title.  
**GEORGE NGUYEN**  
**PRIMARY EXAMINER**